

REMARKS

This Response is submitted in reply to the Office Action dated May 8, 2003. A petition for a one-month extension of time to respond to the Office Action is submitted herein. A check in the amount of \$110.00 is enclosed to cover the fees for the one-month extension. Please charge deposit account number 02-1818 for any insufficiency or to credit any overpayment.

Claims 1, 3 to 5, 8, 9, 11 to 19, 21 to 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,491,584 to Graham et al. ("*Graham*") in view of U.S. Patent Number 6,059,289 to Vancura ("*Vancura*"). Claims 2, 6, 7, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Vancura* and in further view of U.S. Patent Number 6,203,429 to Demar et al. ("*Demar*"). Additionally, Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Vancura* and in further view of U.S. Patent Number 6,533,658 to Walker et al. ("*Walker*"). Applicants respectfully disagree with and transverse these rejections as discussed and agreed upon during the telephone interview.

Regarding the rejection of Claims 1, 3 to 5, 8, 9, 11 to 19, and 21 to 24 under § 103(a), Claim 1 is directed to a gaming device including a processor and a primary game and a secondary game controlled by the processor. The gaming device also includes a secondary game triggering event in the primary game which triggers a secondary game and a secondary game re-triggering event in the secondary game which re-triggers the secondary game. The gaming device further includes an accumulator in the secondary game which is adapted to accumulate secondary game

re-triggering symbols where a secondary game re-trigger is provided to a player when the accumulator accumulates at least two secondary game re-triggering symbols in one or more activations of the secondary game. The combination of *Graham* and *Vancura* does not disclose, teach or suggest the elements of Claim 1.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Moreover, a *prima facie* case of obviousness can be rebutted if the applicant can show that the prior art teaches away from the claimed invention. A reference teaches away when a person of ordinary skill in the art, upon reading the reference, will be led in a direction "divergent from the path" that was taken by the applicant.

Graham discloses a gaming machine including a base game and a series of free games. The gaming machine provides an initial series of free games to a player when a trigger condition occurs in the base game. (Col. 3, lines 5 to 10) A subsequent series of free games is awarded to the player if the same trigger condition occurs in the initial series free games. *Graham*, however, does not disclose, teach or suggest an accumulator in a secondary game which is adapted to accumulate secondary game re-triggering symbols to re-trigger the secondary game when the accumulator accumulates at least two secondary game re-triggering symbols in one or more activations of the secondary game. The Office Action attempts to remedy the deficiencies of *Graham* with *Vancura*.

As discussed during the telephone interview, *Vancura* discloses a gaming machine including a primary slot machine and a secondary slot machine where the

primary slot machine issues a bonus qualifying signal to the secondary slot machine to start play of a bonus game when a bonus qualifying event occurs on the primary slot machine. (Abstract; Col. 4, lines 53 to 64) The bonus game includes a plurality of reels which include value symbols, null symbols, and end game symbols. In one embodiment, the bonus game ends when a predetermined number (N) of the end game symbols are accumulated during play of the bonus game. (Col. 14, lines 42 to 50)

As discussed and agreed upon during the telephone interview, a person of ordinary skill in the art would not be motivated to combine *Graham* and *Vancura* to teach the elements of the claimed invention because *Vancura* teaches away from the claimed invention. Specifically, *Vancura* teaches accumulating a designated number (N) of end game symbols to end a game. When a player accumulates the designated number (N) of end game symbols the game ends and the player cannot continue playing the game.

On the contrary, the present invention is directed to a gaming device including an accumulator in a secondary game which is adapted to accumulate secondary game re-triggering symbols which re-trigger the secondary game when the accumulator accumulates at least two secondary game re-triggering symbols in one or more activations of the secondary game. The present invention re-triggers the secondary game upon the accumulation of at least two secondary re-triggering symbols, which continues or advances the game to enable a player to obtain additional awards in the secondary game. Therefore, *Vancura* teaches a game including an accumulation scheme that accumulates symbols to end a game, which is *completely opposite* to the function of the accumulator in the claimed invention. Therefore, one of ordinary skill in

the art would be led away from combining *Graham* with *Vancura* to achieve the claimed invention because *Vancura* teaches away from the claimed invention. The Examiner agreed that *Vancura* does not teach the claim limitation of an "accumulator in the secondary game to accumulate secondary game symbols to re-trigger the secondary game." (see the Interview Summary)

For these reasons, the combination of *Graham* and *Vancura* does not disclose, teach or suggest the elements of Claim 1 and Claims 2 to 4, which depend from Claim 1. Therefore, Claim 1 and Claims 2 to 4 are each patentably distinguished over the combination of *Graham* and *Vancura* and in condition for allowance.

Independent Claims 5, 14, 15, 16, 17, 19, 21 and 23 include certain similar elements to Claim 1 and specifically the element of an accumulator in the secondary game which is adapted to accumulate secondary game re-triggering symbols, wherein a secondary game re-trigger is provided to a player when the accumulator accumulates a plurality of secondary game re-triggering symbols in one or more activations of the secondary game. As described above for Claim 1, the combination of *Graham* and *Vancura* does not disclose, teach or suggest an accumulator in a secondary game which accumulates a secondary game re-triggering symbols to re-trigger a secondary game in one or more activations of the secondary game. For these reasons, Claims 1, 5, 14, 15, 16, 17, 19, 21 and 23, and Claims 2 to 4 which depend from Claim 1, Claims 6 to 13 which depend from Claim 5, Claim 18 which depends from Claim 17, Claim 20 which depends from Claim 19, Claim 22 which depends from Claim 21 and Claims 24 to 26 which depend from Claim 23, are each patentably distinguished over the combination of *Graham* and *Vancura* and in condition for allowance.

Claims 2, 6, 7, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Vancura* and in further view of *Demar*. Claim 2 depends from Claim 1. Claims 6, 7 and 10 depend from Claim 5. Claim 20 depends from Claim 19. Applicant respectfully submits that Claims 2, 6, 7, 10 and 20 are allowable for at least the reasons set forth above with respect to Claims 1, 5 and 19 because the combination of *Graham*, *Vancura* and *Demar* does not disclose, teach or suggest the novel elements of Claims 2, 6, 7, 10 and 20 in combination with the novel elements of Claims 1, 5 and 19, respectively.

Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* in view of *Vancura* and in further view of *Walker*. Claims 25 and 26 depend from Claim 23. Applicant respectfully submits that Claims 25 and 26 are allowable for at least the reasons set forth above with respect to Claim 23 because the combination of *Graham*, *Vancura* and *Walker* does not disclose, teach or suggest the novel elements of Claims 25 and 26 in combination with the novel elements of Claim 23.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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